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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,661	10/19/2006	Masamoto Tanabikiq	P30639	8628

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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

LABAZE, EDWYN

ART UNIT	PAPER NUMBER
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2876

NOTIFICATION DATE	DELIVERY MODE
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11/02/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary	Application No. 10/598,661	Applicant(s) TANABIKIQ ET AL.	
	Examiner EDWYN LABAZE	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/19/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 9 and 10 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 8, 11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/7/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of IDS filed on 12/7/2006.
2. Claims 1-12 are presented for examination.
3. This application is a 371 of PCT/JP06/00146 filed on 01/10/2006.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 6-7, 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by de Jong (U.S. 7,165,727).

Re claims 1 and 10: de Jong {hereinafter referred as “Jong 727”} discloses method and apparatus for installing an application onto a smart card 102, a card issuance section that extracts a card issuance command {application program, control signal and the like} corresponding to a function of a card to be acquired from command groups stored in an internal memory (col.10,

lines 1-67; col.16, lines 44-67); and a card management section {herein interpreted as the AID interpreter 411; as shown in figs. # 3-5} that executes the card issuance command extracted by said card issuance section (col.37, lines 58-65; col.38, lines 15-23; col.40, lines 59-67; col.41, lines 1-19).

“Jong 727” further teaches a request command a request 805/808 command for requesting card issuance and a command sending section that sends the request command generated to the secure device, when the request command is input, the card issuance command extracted by the card issuance section (col.12, lines 25-58; col.14, lines 27-59; col.26, lines 26-67).

Re claim 2: “Jong 727” teaches method and apparatus, wherein the command group is written {herein means of altering} by direct access from an external device 110 to the internal memory (col.16, lines 58-67; col.17, lines 1-57; col.21, lines 3-61).

Re claim 3: “Jong 727” discloses method and apparatus, wherein said card management section starts to execute the card issuance command based on a request from an external device {herein terminal 110} and sends a response indicating whether or not the card issuance has been successful to the external device (col.28, lines 5-54).

Re claim 6: “Jong 727” teaches method and apparatus, wherein the card issuance section monitors whether or not each card issuance command has been executed successfully at the card management section and outputs, when some card issuance commands have not been executed successfully, information to identify card issuance commands that have been executed successfully to the card management section, and the card management section sends a response including information indicating that some card issuance commands have not been executed

successfully and identifying the card issuance commands that have been executed successfully to the external device (col.12, lines 8-24; col.13, lines 4-23; col.15, lines 10-29).

Re claim 7: "Jong 727" discloses method and apparatus, wherein the card issuance section comprises a direct reference section that directly refers to the command groups stored in the internal memory, and the card management section executes the card issuance command through the direct reference section (col.10, lines 33-67; col.11, lines 1-17).

Re claim 9: "Jong 727" teaches method and apparatus, wherein the card management section comprises a file management table {herein lookup table 810} to identify a file for storing a plurality of command groups corresponding to a plurality of card functions stored in the internal memory and executes a card issuance command which relates to a command group stored in a file specified by the external device (col.26, lines 26-38; col.27, lines 28-67; col.28, lines 1-33).

Allowable Subject Matter

7. Claims 4-5, 8, and 11-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record teaches that the card management application is likely to have privileges that should not be extended to the specific application for account manipulation, but fails to specifically teach:

Re claims 4-5: a privileged mode management section that sets a privileged mode which prevents communication between the card management section and an external device, wherein

the privileged mode management section sets the privileged mode at timing at which execution of the card issuance command is started.

Re claim 8: card management section stores an interruption history in executing the card issuance command, reports a first card issuance command which has not sent any response to the external device to said card issuance section, the card issuance section identifies a card issuance command to be executed first from the interruption history and the first card issuance command which has not sent any response to the external device and restarts execution of the card issuance command.

Re claims 11-12: a response reception section that receives the response and a self-issuance management section that analyzes the response, ends card issuance when the response indicates that card issuance has been successful and outputs an instruction for resending the request command to the command generation section when the response does not indicate that card issuance has been successful. These limitations in conjunction with other limitations in the claimed invention were not shown by the prior art of record.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shona (U.S. 5,592,619) discloses high-security IC card.

Peyret et al. (U.S. 5,923,884) teaches system and method for loading applications onto a smart card.

Hikita et al. (U.S. 6,742,117) discloses IC card and method of using IC card.

Hiltgen (US 2003/0177392) teaches secure user authentication over a communication network.

Mizushima et al. (US 2004/0162932) discloses memory device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Edwyn Labaze
Patent Examiner
Art Unit 2876
October 27, 2007